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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,533	03/15/2004	Vanessa I. Chinea	200315755-1	1334
22879	7590	10/18/2007	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/800,533	CHINEA, VANESSA I.
	<b>Examiner</b>	<b>Art Unit</b>
	D. L. Jones	1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 August 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 9-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 10-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 6, 7, 9, 25, and 26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **ACKNOWLEDGMENTS**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/07 has been entered.
  
2. The Examiner acknowledges receipt of the amendment filed 8/17/07 wherein the specification was amended; claims 6 and 7 were amended; claim 8 is canceled; and claim 26 was added.

**Note:** Claims 1-7 and 9-26 are pending.

## **WITHDRAWN CLAIMS**

3. Claims 1-5 and 10-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

## **COMMENTS/NOTES**

4. Independent claim 6 is interpreted as a pharmaceutical composition consisting of a vehicle and a pharmaceutical ingredient with a solubility of at least about 30 mg/ml wherein the vehicle includes those listed by Applicant in addition to other which are not specifically listed by Applicant.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

5. The Applicant's arguments and/or amendment filed 8/17/07 to the rejection of claims 6-9 and 25 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **112 First Paragraph Rejections**

The 112 first paragraph rejections are WITHDRAWN because Applicant amended the claims to overcome the rejections.

### **103 Rejections**

I. The rejection of claims 6, 7, 9, 25, and newly added 26 under 35 USC 103(a) as being unpatentable over Patel et al (US Patent no. 6,294,192) is MAINTAINED for reasons of record in the office action mailed 5/17/07 and those set forth below.

II. The rejection of claims 6, 7, 9, 25, and newly added 26 under 35 USC 103(a) as being unpatentable over Gardella et al (US Patent No. 4,002,718) in view of Patel et al (US Patent no. 6,294,192) is MAINTAINED for reasons of record in the office action mailed 5/17/07 and those set forth below.

Applicant asserts that the claims have been amended to incorporate the limitations that the solution 'consist essential of' designated ingredients. Also, it is asserted that the solubilizer in both Patel and Gardella may be 2-pyrrolidone or several other possible solubilizers and the greatest proportion of the combination pharmaceutical/ carrier is taken up by the carrier whereas the solubilizing ingredients Patel and Gardella are not taught as possible carriers. In addition, Applicant asserts

that there is no teaching in the prior art that 2-pyrrolidone could be used as a carrier.

Applicant asserts that the pharmaceutical compositions of Patel and Gardella are used in a different form from that of Applicant. In particular, Applicant asserts that there is no suggestion or teaching in achieving a liquid form of the pharmaceutical that is capable of being ejected from a thermal fluid ejection device onto a substrate, after which the vehicle of the pharmaceutical solution very quickly evaporates from the substrate

Applicant's arguments are found non-persuasive for the following reasons.

It is noted that in independent claims 6 and 26, the vehicle is not listed to those set forth in the claims because of the improper Markush terminology present in the claims (see MPEP 803.02). Also, while Applicant has incorporated the transitional phrase 'consisting essentially of' into independent claims 6 and 26 which limits the scope of a claim to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed invention, incorporating a Markush phrase with open terminology ('including' instead of, for example, 'selected from the group consisting of') allows for additional components not set forth in the claim to be present. Furthermore, according to MPEP 2111.03, for the purposes of searching for and applying prior art under 35 USC 103, absent a clear indication in the specification or claims of what is the basic and novel characteristics of the invention, 'consisting essentially of' will be construed as equivalent to 'comprising'.

Applicant is reminded that merely reciting the intended use of an old composition does not impart patentability thereto. Any change in form does not necessarily render an article patentable. In order for the 'new' physical form to be patentable, it must be

more efficacious or possess new properties by a combination with other ingredients and not merely a change of form which has the advantages which one skilled in the art would expect from the change. Furthermore, a compound/composition is inseparable from its properties. Thus, if the pharmaceutical solution of both Patel and Gardella have the same components as Applicant's composition, then the solutions would all behave the same. Also, while Applicant may disclose that 2-pyrrolidone is the carrier and the cited prior art not specifically state that 2-pyrrolidone is the carrier, it does not negate the fact that the same component is present in the composition. Also, Applicant is reminded that patentability of a product is based upon the components of the product, not the intended use (i.e., a thermal ejection fluid) of the product. Thus, a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform that function. Thus, such terminology does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). Hence, if two compositions have the same components, then both Applicant and the cited prior art compositions would be capable of the same use.

Also, in regards to Applicant's assertion that there is no teaching in the cited prior art about achieving a liquid form that is capable of being ejected from a thermal fluid ejection device that evaporates very quickly from the substrate, it is noted that independent claims 6 and 26 are product, not method of use claims. As a result, the steps that occur to the composition (i.e., evaporation) do not affect the patentability of the components present in the composition since for method of use claims, it is the

steps that limit the claims. Hence, the rejection of the claims in light of the prior art of record is deemed proper.

## NEW GROUNDS OF REJECTIONS

### **112 Second Paragraph Rejections**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6, 7, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 26, lines 10 and 8, respectively, contain improper Markush terminology. In particular, proper Markush terminology requires the presence of closed terminology. However, the use of the term 'including' allows for components other than those listed by Applicant to be incorporated into the pharmaceutical solution. Thus, it is unclear whether or not Applicant actually intended to limit the vehicle or not since, for example, in claim 26, line 5, discloses that the 'vehicle includes a component' which also indicates that multiple components may be present in the vehicle. Please clarify.

Claim 7: The claim as written is ambiguous because it is unclear what component Applicant is referring to that remains after evaporation. Claim 7 depends from claim 6 which disclose specific vehicles. However, claim 7 is broader than claim 6 because it simply discloses that the vehicle has a component that remains after evaporation.

Claim 7, line 5: The phrase "low toxicity" in claim 7, line 5 is a relative term which renders the claim indefinite. The phrase "low toxicity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In particular, how one determines what is intended by 'low toxicity' will vary from person to person.

Claim 25: The claim as written is ambiguous because claim 7 has been amended to include the phrase 'consisting essentially of'. However, claim 25 discloses that the solution contains a fluid viscosity and a surface tension that is not necessarily in the range of the components of claim 7. In other words, it is unclear if Applicant is referring to components of claim 6 or unnamed components of claim 7. Please clarify.

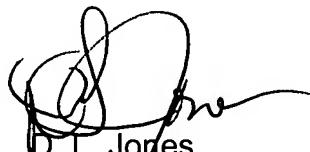
Claim 26, line 5: The phrase "low toxicity" in claim 26, line 5 is a relative term which renders the claim indefinite. The phrase "low toxicity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In particular, how one determines what is intended by 'low toxicity' will vary from person to person.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



D. L. Jones  
Primary Examiner  
Art Unit 1618

October 15, 2007